

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

REMARKS

Claims 1-25 are pending in the present application.

The specification is objected to.

Claim 21 is objected to.

Claims 11-20 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 11-21 and 24 are rejected under 35 U.S.C. §112, ¶2 as being indefinite.

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra, *et al.* ("Misra") in view of U.S. Pub. No. 2005/0071280 to Irwin *et al.* ("Irwin"), and further in view of U.S. Patent No. 7,343,297 to Bergler, *et al.* ("Bergler").

Claims 1, 11, 21, and 23-24 are amended within the subject matter of the application as filed. It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

OBJECTIONS

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. The Examiner pointed to the following as needing correction due to lack of antecedent basis:

"a first subset of the plurality of rights of license rights"
"a second subset of license rights."

04/28/2010 Office Action, pp. 2-3. Applicant respectfully disagrees and submits that support for the claimed subject matter can be found at least in paragraphs [0030-0031], [0034], [0038-0041].

Applicant : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

and [0059]. Therefore applicant respectfully submits that the Examiner's objection to the specification has been overcome.

Claims

Claim 21 is objected to for lack of a comma. 04/28/2010 Office Action, p. 3. Claim 21 is amended herein and applicant respectfully submits the Examiner's objection to Claim 21 has been overcome.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §101

Claims 11-20 are alternatively rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner stated:

Claim 11 recites a computer program only...because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention.

04/28/2010 Office Action, pp. 3-4. Applicant respectfully disagrees because the rejections are improper in light of at least Section IV of the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*. Federal Register, Vol. 75, No. 143, Tuesday July 27, 2010. Section IV states, in part:

Where the claim is written in the form of a method and is potentially a patentable process, as defined in 35 U.S.C. 100(b), the claim is patent eligible so long as it is not disqualified as one of the exceptions to §101's broad patent eligibility principles...Examiners will recognize that the machine-or-transformation test set forth in Section II(B) of the 2009 Interim Instructions...not the sole test for evaluating the subject matter eligibility of a method claim.

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Doga.
Docket No. : 20503-4023

Section IV, Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos. Therefore, applicant respectfully submits the Examiner's rejections of Claims 11-20 under 35 U.S.C. §101 have been overcome.

Rejections under 35 U.S.C. §112

Claims 11-21 and 24 are rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the invention. Regarding the rejection of Claims 1, 11, and 21, the Examiner states:

Claim 11 is indefinite because the claim is considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a "process" nor a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

04/28/2010 Office Action, pp. 4-6. Claim 11 is amended herein to clarify being directed to a "system." Applicant respectfully submits that the Examiner's rejection of Claim 11 under 35 U.S.C. §112 has been overcome.

The Examiner further stated a need for clarification regarding the use of "the one computer" in Claims 11 and 24. 04/28/2010 Office Action, p. 5. Claims 11 and 24 are amended herein, and applicant respectfully submits the Examiner's rejections of Claims 11-21 and 24 under 35 U.S.C. §112 have been overcome.

Rejections under 35 U.S.C. §103(a)

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Irwin and further in view of Bergler. Applicants respectfully disagree and submit that Claims 1-25 are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin and further in view of Bergler. Regarding the rejection of Claim 1, the Examiner stated:

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

Misra...does not disclose set or subset of license rights. However, Irwin teaches rightsholder selling or license all rights or subset of rights ("license those rights or subset of rights", ¶[0007]).

04/28/2010 Office Action, pp. 8. Applicants respectfully disagree for the following reasons.

Claim 1 is amended to recite:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 1, emphasis added. Irwin does not provide such a teaching either. Irwin describes protecting the distribution of digital information while allowing a user to authorize the user of digital information on a variety of devices. Irwin, ¶[0003]. An intermediate rights provider receives a master license, and a child license can be created from the master license. Irwin, ¶[0054]. A child license is a license whose rights depend from the master license. *Id.* Multiple devices registered within a local rights provider can access a key to all licensed digital content. Irwin, ¶[0159]. Transferring of digital rights from one local rights provider is completed in entirety. Irwin, ¶[0166]. In other words, Irwin describes a master license that covers multiple devices, and a child license can be created from the master license. Irwin does not disclose:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 1, emphasis added.

Bergler does not provide such a teaching either. Bergler describes that any license previously issued to a client that has been returned by the license clean-up module is subject to being given to a different client. Bergler, col. 12, lines 14-17. Bergler's license includes a list of features to be enabled. Bergler, col. 10, lines 55-56. In other words, Bergler describes issuing a

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

license having a list of enabled features to a client, and the client returning the license. Bergler does not disclose:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 1, emphasis added. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 1, and Claims 2-10 that depend from Claim 1, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 11 has been rejected for the same reasons as Claim 1 above. Claim 11 discloses substantially similar limitations as Claim 1, including:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 11, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 11, and Claims 12-20 that depend from Claim 11, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 11 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Misra, Irwin and Bergler as described above and further in view of Fig. 2, 40 of Misra. The Examiner stated:

Claim 11 is rendered obvious as noted above because a computer as depicted in Fig. 2 of Misra, consists of storage capabilities to store copy of software application, store license information, store software application information, store computer identification information, and can operatively link all the information stored on the computer as linked by the System Bus.

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

04/28/2010 Office Action, p. 13. Applicant respectfully disagrees for at least the following reasons.

Claim 11 is amended to recite:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 11, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin nor Bergler provide such a teaching. Fig.2, 40 of Misra does not teach or suggest such a feature either. Figure 2 of Misra shows a block diagram of a computer used to implement a software licensing system described by Misra. Misra, col. 3, lines 33-35. As discussed above, the software licensing system described by Misra does not teach all of the features of Claim 11.

Figure 2 of Misra does not teach:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 11, emphasis added. Because neither Misra, Irwin, Bergler, nor Fig. 2 of Misra, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 11, and Claims 12-20 that depend from Claim 11, are patentable under 35 U.S.C. §103(a) over Misra, Irwin and Bergler and further in view of Fig. 2, 40 of Misra.

Claim 21 is rejected for the same reasons as Claim 1 above. Claim 21 discloses substantially similar limitations as Claim 1, including:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 21, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin, nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that

Applicant : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

Claim 21, and Claim 22 that depends from Claim 21, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 23 is rejected for the same reasons as Claim 1 above. Claim 23 discloses substantially similar limitations as Claim 1, including:

the first subset of the plurality of license rights does not include license rights contained within the second subset of the plurality of license rights.

Claim 23, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin, nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, applicants respectfully submit that Claim 23, and Claims 24-25 that depend from Claim 23, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7400. If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,
ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: September 28, 2010 _____ By: /s/ Sanjeet K. Dutta _____
Sanjeet K. Dutta
Reg. No. 46,145

Orrick, Herrington & Sutcliffe LLP
4 Park Plaza, Suite 1600
Irvine, California 92614-2558
(650) 614-7647 (telephone)
(650) 614-7401 (facsimile)